

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Virinder BATRA, et al.	:	Confirmation Number: 3519
	:	
Application No.: 10/077,012	:	Group Art Unit: 2145
	:	
Filed: February 15, 2002	:	Examiner: A. Choudhury
	:	
For: COMMON LOCATION-BASED SERVICE ADAPTER INTERFACE FOR LOCATION BASED SERVICES		

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated June 11, 2008.

The Examiner's response to Appellants' arguments submitted in the Third Appeal Brief of March 12, 2008 (hereafter the Third Appeal Brief), raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellants rely upon the arguments presented in the Third Appeal Brief and the arguments set forth below.

REMARKS

At the outset, before addressing the Examiner's response to Appellants' arguments presented in the Third Appeal Brief, Appellants respectfully submit that the Examiner has submitted a non-compliant Examiner's Answer. As is evident from the extensive comments presented by Appellants during prosecution of the present Application and in the Third Appeal Brief, there are questions as to how the limitations in the claims correspond to features in the applied prior art. In this regard, reference is made to M.P.E.P. § 1207.02, entitled "Contents of Examiner's Answer." Specifically, the following is stated:

(A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

...

(9)(c) For each rejection under 35 U.S.C. 102 or 103 where there are questions as to how limitations in the claims correspond to features in the prior art even after the examiner complies with the requirements of paragraphs (c) and (d) of this section, the examiner must compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison must align the language of the claim side-by-side with a reference to the specific page, line number, drawing reference number, and quotation from the prior art, as appropriate. (emphasis added)

However, upon reviewing the Examiner's Answer, Appellants note a lack of a section within the Examiner's Answer that meets the requirements described in the aforementioned section. Thus, the Examiner's Answer is non-compliant and further evidences the Examiner's continued failure to clearly identify the features within the prior art being relied upon by the Examiner in rejecting the claims and continued failure to clearly explain the pertinence of the applied prior art, as required by 37 C.F.R. § 1.104(c).

Appellants have compared the statement of the rejection found on pages 4-6 of the Examiner's Answer with the statement of the rejection found on pages 2-5 of the Sixth Office

Action. Upon making this comparison, Appellants have been unable to discover any substantial differences between the respective statements of the rejection. As such, Appellants proceed on the basis that the Examiner's sole response to Appellants' Third Appeal Brief is found on pages 7-9 of the Examiner's Answer.

On page 5 of the Third Appeal Brief, Appellants pointed out where the Examiner's Answer is required to include particular content discussed in M.P.E.P. § 1207.02, yet the Examiner has completely ignored this requirement. As noted throughout the prosecution of this application and in the Third Appeal Brief, the Examiner has failed to properly establish the facts underlying the Examiner's analysis. Appellants' position is that these omissions in the Examiner's prima facie analysis are correctable by the Examiner, and the correction of these omissions would help both Appellants and the Honorable Board gain a better understanding of the underlying facts and analysis employed by the Examiner in rejecting the claims. Thus, Appellants respectfully recommend that the Honorable Board remand the present application to the Examiner to address these omissions.¹

On page 5, lines 8-20 of the Third Appeal Brief, Appellants noted that the Examiner, in one instance, asserted that Requena teaches all of the claimed limitations, yet in another instance,

¹ The Board has persistently declined to uphold an Examiner because of omissions in the Examiner's half of the record. *E.g.*, Ex parte Dalciden, Appeal 2007-1003 (Mar. 14, 2007) (remanding because examiner failed to respond to arguments in the Appeal Brief); Ex parte Rozzi, 63 USPQ2d 1196, 1200-03 (BPAI 2002) (McKelvey, J.) (remanding without decision because of a host of examiner omissions and procedural errors); Ex parte Gambogi, 62 USPQ2d 1209, 1212 (BPAI 2001) (McKelvey, APJ) ("We decline to tell an examiner precisely how to set out a rejection."); Ex parte Jones, 62 USPQ2d 1206, 1208 (BPAI 2001) (McKelvey, APJ) (refusing to adjudicate an issue that the examiner has not developed); Ex parte Schricker, 56 USPQ2d 1723, 1725 (BPAI 2000) ("The examiner has left applicant and the board to guess as to the basis of the rejection ... We are not good at guessing; hence, we decline to guess."); Ex parte Bracken, 54 USPQ2d 1110, 1112-13 (BPAI 1999) (McKelvey, APJ) (noting that the appeal is "not ripe" because of omissions and defects in the examiner's analysis).

the Examiner is asserting that Requena does not teach all of the claimed limitations. Thus, the Examiner has not clearly characterized the differences between the claimed invention and the applied prior art since on one hand, which is one of the Graham factual inquiries. The Examiner neither addressed these arguments in the "Grounds of Rejection" section or the "Response to Argument" section of the Examiner's Answer.

On page 6 of the Third Appeal Brief, Appellants presented arguments regarding the claimed "determining from each said request a particular location-based service provider which can service said request." As discussed therein, Appellants have consistently argued since at least the First Appeal Brief that Requena fails to teach all of these limitations, and the Examiner has yet to address these arguments.

The Examiner's response to these arguments is found on the last full paragraph page 7 of the Examiner's Answer and reproduced below:

Within these cited sections, Requena teaches a system wherein presence service is provided based on spatial location information. For instance, Requena provides the example of a user wanting to know about what services are available in his surroundings (see paragraph 209, Requena). The user requests a specific service with his mobile terminal (paragraph 209, Requena). After the user sends his request, the CSCF checks the information of the user for location information and obtains service information from the Location Based Services server (paragraph 213, Requena). The user then receives a response with the requested service adapted to his physical situation (paragraph 209, Requena). Hence, a user requests a service based on his location and a determination is made (based on the user's location and service request) and sent to the user informing him of the best service available based on his location. This is deemed equivalent to the applicant's claimed limitation. (emphasis added)

Based upon the Examiner's own citation, Requena does not appear to teach the limitations at issue. Specifically, referring to the underlined portion above, the user requests a specific service with his mobile terminal. As such, the user appears to already know to what

specific service the request will be sent. Thus, Requena does not teach "determining *from each said request* a particular location-based service provider" as no determining step need be performed. Although the teachings of Requena are not entirely clear, in paragraph [0212], Requena teaches that the user is able to open a session and "ask for some information." In this manner, the user may be able to determine, before sending the request, what specific service the user wants. Thus, Appellants maintain that Requena fails to teach the limitations for which the Examiner is relying upon Requena to teach.

On pages 7-9 of the Third Appeal Brief, Appellants presented arguments as to limitations that were added to claims 1, 3, and 5 in an Amendment dated December 13, 2005. Appellants' position is that Requena fails to teach these limitations and that the Examiner has not explicitly addressed these limitations in subsequent Office Actions.

The Examiner's response to these arguments is found on the last full paragraph page 7 of the Examiner's Answer and reproduced below:

The examiner would like to point out that if such language were vital to the claimed invention, the applicant had the option to insert it within the body of the claim, as opposed to the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

At the outset, Appellants respectfully submit that the Examiner's suggestion regarding placement of the claim language is disingenuous. The Examiner had opportunities in the Third, Fourth, Fifth, and Sixth Office Actions to make these assertions, but the Examiner failed to do so. As

such, Appellants proceeded, in subsequent responses, on the belief that the Examiner was properly giving patentable weight to the limitations at issue.

Of particular note is that the Examiner's assertion regarding the limitations in the preamble does **not** apply to independent claim 3 since the limitation at issue (i.e., "aid uniform input interface adapted to be connected to different service adapters specifying different formats for receiving inputs") is found within the body of the claim and not the preamble.

Notwithstanding the Examiner's very untimely assertions, the Examiner's analysis is simply a conclusory statement that lacks factual support. The limitations at issue (i.e., "different ones of said plurality of disparate location-based service providers specifying different formats for receiving said requests") in independent claims 1 and 5 do not recite the purpose of a process, as alleged by the Examiner. Instead, these limitations recite a characteristic (i.e., format) of a "request," which relates to the claimed step of "specifically formatting each said request according to a specific format specified by said particular location-based service provider." Thus, since the disparate location-based service providers specify different formats, the claimed step of "specifically formatting" requires that different formatting be applied depending upon the particular location-based service provider. Therefore, these limitations, which are found in the preamble, give additional meaning to the limitations within the body of the claim, and thus, the Examiner has erred by failing to give these limitations patentable weight.²

² "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999).

On pages 9 and 10 of the Third Appeal Brief, Appellants addressed the Examiner's secondary reference of Lee and the Examiner's obviousness analysis. The Examiner's response to these arguments is found on pages 8 and 9 of the Examiner's Answer and is reproduced below:

The applicant contends that neither prior art teach the above claim limitations, the examiner disagrees. Requena teaches that requests are to be of a specified format (see paragraph 107, Requena). In addition, the CSCF sends the results back in a specified format (see paragraph 215, Requena). While Requena's design teaches location-based services and formats for messages, Requena does not explicitly teach a uniform format for the results produced from corresponding requests.

This is why the Lee prior art was introduced. Lee also teaches a location-based system (GML requests) that standardizes messages to a uniform language (the uniform language being XML) (*see second paragraph of the introduction and section II, sub-section B, Lee*). Within section II, sub-section B of Lee's disclosure, Lee teaches, "encoding rules from geographical data to XML," and XML encoding of geographical data. Converting the geographical data to XML allows the geographical data to be presented in a more standardized/uniform way (see 2nd paragraph of the Introduction, Lee). Hence, Lee teaches how geographical data is uniformly formatted into XML. Thus for these reasons, it is believed that the prior arts, in combination, do teach the claimed limitations.

At the outset, Appellants note that certain of the arguments previously presented by Appellants in the Third Appeal Brief depend upon the limitations found in the preamble of independent claims 1 and 5 and in the body of the claim of independent claim 3. However, as already discussed, the Examiner has ignored these claim limitations.

The first half of the above-reproduced second paragraph is substantially identical to the Examiner's prior assertions on page 5 of the Examiner's Answer. The second half of the second paragraph is essentially an assertion, by the Examiner, that Lee teaches uniformly formatting geographic data into XML. The Examiner's comments, however, are not germane to the limitations being argued which were directed to the concept that the requests sent to the particular location-based service providers are not uniformly formatted because the location-based service providers specify different formats. Thus, the Examiner has not addressed the

1 substance of Appellants' arguments presented on page 9, line 25 through page 10, line 11 of the
2 Third Appeal Brief.

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4 Regarding Appellants' additional arguments on page 10, lines 13-21, the Examiner did
5 not respond to these arguments in the Examiner's Answer.

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For the reasons set forth in the Third Appeal Brief and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: August 8, 2008

Respectfully submitted,

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CUSTOMER NUMBER 46320